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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,663	11/17/2000	Nathalie Garnier	05725.0810-00000	4399

22852 7590 03/11/2002

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EXAMINER

QAZI, SABIHA NAIM

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 03/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/714,663

Applicant(s)  
Garmier et al.

Examiner  
Sabiha Qazi

Art Unit  
1616



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 21, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-100 is/are pending in the application.
- 4a) Of the above, claim(s) 11-99 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 100 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 45-99 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

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### First Office Action on Merits

Claims 11-100 are pending.

Claim 100 is examined, others are withdrawn from consideration as non elected invention.

Response filed in paper no. 8, dated 12/8/01 and the election of species with traverse of the compound, imino(phenylamino) methane sulphinic acid. Reply is not fully responsive because no group was elected. Examiner notes that original claims (1-10) are canceled and new claims 11-100 are added which are broader than original presentation. Applicant's argument regarding traversal were fully considered but are not found persuasive. The basis of traversal is on the ground(s) that there will be no serious burden to search and examine all the invention because they are all similar. Furthermore, it has been argued that classification of all the groups is same. Even though all the composition, compounds and process are different inventions and are separately classified, Examiner did not emphasized on classification. The inventions as claimed are distinct, each from the other drawn to the invention which require separate searches, and are not art recognized equivalents. For example the search for the invention of group I, will not be the same as any other group. They are patentably distinct. A reference used to reject invention of one group would not be used for any other group.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as the search required for Group I is not required for Group II, III or any other groups, and have acquired a separate status in the art because of their recognized divergent subject matter. The database and other searches for the entire genus would represent excessive burden on the Examiner. The restriction for examination purposes as indicated is proper.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

2. Claim 100 rejected under 35 U.S.C. 102(b) as being anticipated by Yarovenko et al. (DN 73:34993, CAPLUS, abstract of Zh. Org. Khim. (1970), 6(5), 947-9).

See RN 14451-43-5 which is imino(phenylamino) methane sulphinic acid. Same compound is the elected species and claimed in claim 100.

***Telephone Inquiry Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha N. Qazi, whose telephone number is (703) 305-3910. The examiner can normally be reached on Monday through Friday from 8 a.m. to 6 p.m. The fax phone number for this Group is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

3/6/02



**Sabiha N. Qazi, Ph.D.**

**Primary Examiner**

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